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09/922,028	08/03/2001	Dominic Dough-Ming Cheung	9623-329	9269
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EXAMINER COLBERT, ELLA				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/922,028

Applicant(s)

CHEUNG ET AL.

Examiner

Ella Colbert

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 72-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 72-79 are pending. Claims 72 and 73 have been amended in this communication filed 09/09/08 entered as Amendment with filing of RCE. An Extension of time was filed 09/25/08 and entered.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/09/08 has been entered.

Claim Objections

Claims 72 and 74-79 are objected to because of the following informalities: Claims 72 and 74 recite "CPC" and claims 75-79 recite "Cost per click" which means the claims are not in agreement resulting in an inconsistency in the claims to the invention. A comma needs to be after "advertiser inputs" and before the "wherein" clause. Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Page 23, line 24 references "advertiser web pages 18"; Figure 7, element "710" -this makes it impossible for there to be a search result item display "710" and

select or "click" on "hyperlink 730" of the search result item display "710"; Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 5, element "342"; Fig. 7 elements "760 b-760h"; Fig. 10 element "1008"; Fig. 16 elements "1608" and "1610"; Fig. 20 element "2030"; Fig. 23 element "2312"; Fig. 25 element "2512"; Fig. 29 element "2910"; Fig. 35 element "3502"; Fig. 36 element "3610"; Fig. 39 elements "3908" and "3916"; and Fig. 40 referenced on Page 82, line 26 is missing. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of

an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because Figure 36 has the stamp through part of the drawing on the left side of the drawing figure page. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The Specification is objected to because Page 1, lines 5-10 recite "This application is a continuation in part of application serial number xx/xxx,xxx, ... (attorney docket number 9623/334), ..., ..., ..., ..., ... 6,269,361. The application number needs to be inserted, the attorney docket number needs to be deleted, the status of the application needs to be entered as "pending" or "patent no. " and the comma after 6,269,361 needs to be deleted. Correction is required. See MPEP § 608.01(b).

The compact disk appendix is missing from the file. Applicants' are respectfully requested to submit the disk if they want it to be considered or delete this section in the Specification.

Page 9, line 2 recites "provided by ... and is source of cost to". This line should recite "provided by ... and is a source of cost to".

Page 19, lines 29 and 30 recites "web pages or records 30 stored on advertiser server 14. The browser programs 16 ... web pages 3." The drawing figure references "web pages 30" as "advertiser web pages 30" and "advertiser server 14" as "advertiser web server 14" and "browser programs 16" as "browser 16".

Page 19, line 32-page 20, lines 1, 3, 15, 26; Page 21, lines 6 and 7 have a similar problem. Page 20, line 11 recites "search engine server" and the drawing references "search engine web server 24". Lines 14 and 15; Page 22, line 6 and line 17; Page 23, line 12 has a similar problem. Page 20, lines 20 and 21 references "storage medium 32" and the drawing has "storage 32". Page 22, line 2 references "storage 32". The drawing recites "processing system 34" and Page 22, lines 12 and 13 recites "processor 34".

Applicants' reference numbers for the elements in the drawing figures and what is referenced in the Specification are not in agreement.

The Specification on page 21, line 9 contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 72-79 re rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 72-79 have insufficient support for the claim limitations such as a search engine providing search results including search listings according to rank; at least some of the search listings being ..., ...; and the other limitations of claim 72 and claims 73-79. Applicants' are respectfully requested to point out where support is found in the Specification and/or drawings for claims 72-79.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 72 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,078,866) Buck et al, hereafter Buck in view of (US 6,907,566) McElfresh et al, hereafter McElfresh.

Claim 72. Buck discloses, A database searching apparatus comprising:

a search engine operative to provide search results including search listings according to rank (col. 6, lines 48-61 and col. 3, line 35 -col. 4, line 12 and lines 49-59); and a database searchable by the search engine and including a plurality of search listings, at least some search listings being associated with advertisers (Fig.'s 1A and 1B), the search listing associated with an advertiser including a search term specified by the advertiser (col. 7, lines 15-28).

Buck failed to disclose, a desired rank specified by the advertiser for a search listing and a maximum cost per click (maximum CPC) and a cost per click (CPC) associated with the desired rank for the search term and the advertiser, account management server means in data communication with the database for automatically adjusting the CPC for a search listing in response to advertiser inputs; wherein, when the advertiser enters a new search listing or changes the maximum CPC of a search listing the account management server means. McElfresh discloses, a desired rank specified by the advertiser for a search listing and a maximum cost per click (maximum CPC) and a cost per click (CPC) associated with the desired rank for the search term and the advertiser, account management server means in data communication with the database for automatically adjusting the CPC for a search listing in response to advertiser inputs; wherein, when the advertiser enters a new search listing or changes the maximum CPC of a search listing the account management server means (col. 2, line 18- col. 3, line 19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Buck with the teachings of McElfresh because such a modification would allow Buck to perform a calculation for each ad

along with its price-per-click to determine placement of the ads on a website for optimum click-through occurrences and generation of revenue (col. 3, lines 46-64).

Buck further discloses, to adjust the CPC of the advertiser's search listing to maintain the desired rank, move the search listing to the highest rank possible without exceeding the maximum CPC of the advertiser's search listing (col. 7, line 58-col. 8, line 38 and col. 8, lines 42-67), maintain the CPC of the advertiser's search listing less than or equal to the maximum CPC of the advertiser's search listing, set the CPC of the advertiser's search listing no higher than necessary (col. 9, lines 1-13), and avoid setting the CPC of the advertiser's search listing so that desired ranks and CPCs of other advertisers are maintained (col. 9, lines 16-31). The fact that the server is an account management server does not change the result that is achieved. Infact, for the server to be an account management server does not change its intended use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 73-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,078,866) Buck et al, hereafter Buck in view of Official Notice.

Claim 73. Buck failed to disclose, The database searching apparatus of claim 72 wherein the database further stores a timestamp associated with each desired rank, the timestamp indicating a time the search listing was entered or changed. Official Notice is taken that it is old and well known for a database to store a timestamp associated with the desired rank and the timestamp to indicate a time the search listing was entered or changed. It is well known that in the Internet art that web pages are timestamped and can be ranked and placed in database storage with the time the web page was last modified or ranked.

Claim 74. Buck discloses, the database searching apparatus of claim 73 wherein the search engine is configured to receive a search request (col. 1, lines 44-55 -Background Art); locate one or more search listings having a matching relationship with the search request (col. 1, line 66-co1.2, line 11 (Background Art)); and order search results from the one or more search listings using the CPC associated with the one or more search listings (col. 3, line 53-col. 4, line 47).

Claim 75. Buck failed to disclose, The database searching apparatus of claim 72 further comprising: an account manager accessible by the advertiser to vary at least one of the maximum cost per click and the desired rank for a respective bid and desired rank. Official Notice is taken that a bid and a desired rank is well known when bidding on advertisement placement or bidding on most things a person desires a rank according to their bid.

Claim 76. Buck failed to disclose, The database searching apparatus of claim 75 wherein the account manager is further accessible by the advertiser to vary the maximum cost per click for two or more possible ranks specified by the advertiser. It is well known in the art of advertising on the Internet to pay per clickthrough for ranking in advertising.

Claim 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,078,866) Buck et al, hereafter Buck in view of Official Notice and further in view of "Mobile Agents".

Claim 77. Buck failed to disclose, The database searching apparatus of claim 72 further comprising: one or more software agents configured to receive advertiser bid information, and act on the advertiser bid information to adjust the cost per click for a specified search listing. "Mobile Agents" discloses, The database searching apparatus of claim 72 further comprising: one or more software agents configured to receive advertiser bid information, and act on the advertiser bid information to adjust the cost per click for a specified search listing (pages 1(3) -page 4(4)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of "Mobile Agents" in Buck because such an incorporation would allow Buck to have a more efficient way of receiving advertiser bid information.

Claim 78. Buck discloses, The database searching apparatus of claim 77 wherein the one or more software agents is configured: to increase the current cost per click of the specified search listing if the rank of the specified search listing can be improved without exceeding the maximum cost per click (col. 4, lines 13-48); and decrease the current

cost per click of the specified search listing without moving the specified search listing to a rank worse than the desired rank (col. 4, line 49-co1.5, line 3 and line 62-co1.6, line 67).

Claim 79. Buck discloses, The database searching apparatus of claim 78 wherein the one or more software agents are configured to decrease the current cost per click of the specified search listing only if no other search listing will have its respective current cost per click increased to decrease the rank of the specified search listing (col. 7, line 57-co1.8, line 38).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ryan et al (US 6,421,675) disclosed a search engine and the cost-per-click.

McElfresh et al (US 7,373,599) disclosed a server and the cost-per-click.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

November 20, 2008